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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
SEL 163

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on April 24, 2006

Signature Shannon Wallace

Typed or printed name Shannon Wallace

Application Number
09/516,082

Filed
March 1, 2000

First Named Inventor
Satoshi Murakami

Art Unit
2815

Examiner
Eugene Lee

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)
- ☒ attorney or agent of record.
Registration number 34,225
- ☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Mark J. Murphy
Signature

Mark J. Murphy
Typed or printed name

312-236-8500
Telephone number

April 24, 2006
Date

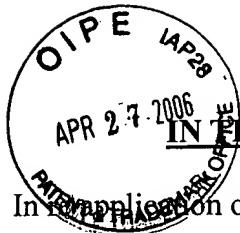
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 2 forms are submitted.

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Attorney Docket No. 0553-0163

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Reply, please refer to:

Satoshi Murakami, et al.

Serial No: 09/516,082

Filed: March 1, 2000

Art Unit: 2815

Examiner: Eugene Lee

For: SEMICONDUCTOR DEVICE
AND METHOD OF
MANUFACTURING THE SAME

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April 24 2006

(Date of Deposit)

Shannon Wallace

Name of applicant, assignee, or Registered Rep.

Shannon Wallace 4/24/06

Signature

Date

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REASONS FOR REVIEW OF FINAL REJECTION

Dear Sir:

In support of the Notice of Appeal and Pre-Appeal Brief Request For Review filed herewith, Applicants are requesting review for the following reasons:

Claims Rejections - 35 USC §103

In the Final Rejection, the Examiner has the following rejections under 35 USC §103:

- A. Claims 46, 47, 59, 65, 89, 90, 96, 99, 100, 106, 109, 110, 116, 139, 140 and 144 are rejected as being unpatentable over Kadota et al. (US 5,818,550) in view of Yanai.
- B. Claims 48, 49, 52, 53, 60, 61, 66, 67, 91, 92, 97, 98, 101, 102, 107, 108, 111, 112, 117, 118, 141 and 145 are rejected as being unpatentable over Kadota et al. in view of Yanai and further in view of Seo (US 6,323,521).
- C. Claims 56, 62, 71, 74, 93, 103, 113 and 142 are rejected as being unpatentable over Kadota et al. in view of Yanai and further in view of Ha (US 5,677,207).
- D. Claims 57, 58, 63, 64, 72, 73, 75, 76, 94, 95, 104, 105, 114, 115 and 143 are

rejected as being unpatentable over Kadota et al. in view of Yanai in view of Seo and further in view of Ha.

- E. Claims 77, 78 and 86 are rejected as being unpatentable over Kadota et al. in view of Yanai and further in view of Matsumoto (US 5,323,042).
- F. Claims 79, 81, 87 and 88 are rejected as being unpatentable over Kadota et al. in view of Yanai in view of Seo and further in view of Matsumoto.
- G. Claim 68 is rejected as being unpatentable over Kadota et al. in view of Yanai and further in view of Mikoshiba (US 5,499,123).
- H. Claims 69 and 70 are rejected as being unpatentable over Kadota et al. in view of Yanai in view of Seo and further in view of Mikoshiba.
- I. Claim 83 is rejected as being unpatentable over Kadota et al. in view of Yanai in view of Ha and further in view of Matsumoto.
- J. Claims 84 and 85 are rejected as being unpatentable over Kadota et al. in view of Yanai in view of Seo in view of Ha and further in view of Matsumoto.
- K. Claims 119, 120 and 126 are rejected as being unpatentable over Kadota et al. in view of Yanai and further in view of Kunii et al. (US 5,412,493).
- L. Claims 121, 122, 127 and 128 are rejected as being unpatentable over Kadota et al. in view of Yanai in view of Seo and further in view of Kunii et al.
- M. Claim 123 is rejected as being unpatentable over Kadota et al. in view of Yanai in view of Ha and further in view of Kunii et al.
- N. Claims 124 and 125 are rejected as being unpatentable over Kadota et al. in view of Yanai in view of Seo in view of Ha and further in view of Kunii et al.
- O. Claims 129, 130 and 136 are rejected as being unpatentable over Kadota et al. in view of Yanai further in view of Kadota et al. '512 (US 6,031,512).
- P. Claims 131, 132, 137 and 138 are rejected as being unpatentable over Kadota et al. in view of Yanai in view of Seo and further in view of Kadota et al. '512.
- Q. Claim 133 is rejected as being unpatentable over Kadota et al. in view of Yanai in view of Ha and further in view of Kadota et al. '512.
- R. Claims 134 and 135 are rejected as being unpatentable over Kadota in view of Yanai in view of Ha and further in view of Kadota et al. '512.

Each of these rejections is respectfully traversed.

More specifically, each of these rejections is based on the combination of Kadota and

Yanai (and other references). Applicants respectfully submit that these rejections are improper as a *prima facie* case of obviousness has not been established.

MPEP §2142 is directed to what is necessary for establishing a *prima facie* case of obviousness. The burden is initially on the Examiner to establish a *prima facie* case of obviousness. If the Examiner does not establish a *prima facie* case, then the rejection is improper and should be withdrawn. To establish a *prima facie* case of obviousness, there must be some suggestion or motivation to modify or combine references. MPEP §2142 states that:

“When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper...A statement of a rejection that includes a large number of rejections must explain with reasonable specificity at least one rejection, otherwise the examiner procedurally fails to establish a *prima facie* case of obviousness.” [citations omitted]

In this case, the Examiner has failed to show a proper motivation to combine Kadota and Yanai to arrive at the claimed invention.

In particular, in the Final Rejection, the Examiner contends that “it would have been obvious to one of ordinary skill in the art at the time of the invention to have a color filter, wherein the color filter covers the entire first thin film transistor in order to provide a color filter that can adequately emit multiple colors from a thin film transistor” (page 2 of Final Rejection). This apparently is the Examiner’s alleged motivation to combine Kadota and Yanai. There is, however, no support in the cited references for this alleged motivation as none of the cited references disclose “provide a color filter that can adequately emit multiple colors from a thin film transistor,” and the Examiner has provided no explanation of where this alleged motivation may be found. Further, this statement provides no explanation or support for use of a color filter that covers the entire first thin film transistor, as recited in the claimed invention, and is not even directly related to this claimed feature. At most, it could be said that this is a general feature of some but not all color display devices or color filters.

The Examiner provides further comments on page 15 of the Final Rejection. These comments, however, appear to be mere hindsight arguments by the Examiner without any basis in the reference.

Hence, there is no proper motivation provided in the Final Rejection for the combination of Kadota and Yanai, and therefore, no prima facie case of obviousness has been established, and all of the §103(a) rejections which are based on this combination are defective. Accordingly, it is respectfully requested that all of the §103(a) rejections be withdrawn.

Claims 129 to 138

Further, Claims 129-138 recite that the gate electrode is covered by the interlayer insulating film. The Examiner contends that Kadota teaches a gate electrode covered by an interlayer insulating film 4. However, it is not seen how interlayer insulating film 4 in Kadota covers the gate electrode 3. Therefore, it is respectfully requested that this rejection be withdrawn.

Claims 139-145

Further, Claims 139-145 recite a second conductive layer formed over the interlayer insulating film and electrically connected to the other of the source and drain regions of the first thin film transistor, wherein the color filter covers an entire surface of the first conductive layer and an entire surface of the second conductive layer except for a part of the first conductive layer overlapping the opening through which the pixel electrode is electrically connected to the first conductive layer.

This feature is not disclosed or suggested by cited references. For example, Yanai discloses the surface of drain electrode 6 partially covered by color filters 9 but also covered by

film 10 (not an opening for pixel electrode as in Claims) 10 and not covered by a single color filter. As the Examiner admits Kadota does not disclose a single color filter that covers the entire first film transistor. The Examiner's arguments on page 15 do not address the specifics of the claim language and what is shown in Yanai. Therefore, Claims 139-145 are not disclosed or suggested by the cited references and are patentable thereover.

Conclusion

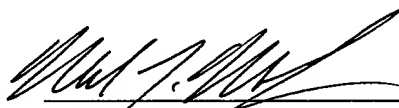
Accordingly, Applicants request review of the rejections, reversal of the rejections, and allowance of the claims.

Favorable consideration is earnestly solicited.

Respectfully submitted,

Date:

April 24, 2006



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